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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,360

10/10/2006

Jean-Marie Gouot

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EXAMINER

PAK, JOHN D

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,360	<b>Applicant(s)</b> GOUOT ET AL.	
	<b>Examiner</b> John Pak	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/06, 1/10</u> . | 6) <input type="checkbox"/> Other: _____  |

Claims 1-14 are pending in this application.

Applicant's election with traverse of Example I, a mixture of Compound I and cyprodinil, in the reply filed on 1/22/2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-14 will presently be examined to the extent that they read on the elected subject matter of record.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) Independent claim 1 and several other dependent claims recite component (a) as a pyridylethylbenzamide derivative of "general formula (I)" (emphasis added). The term "general" renders the claim indefinite because it is not clear whether the formula given in claim 1 is merely one general possibility, i.e. the claims are open to other pyridylethylbenzamides that do not have the structure of formula (I).

(2) At line 14 of claim 1, "as to the N-oxides of 2-pyridine thereof" is unclear, grammatically incorrect, and lacks antecedent basis.

(3) At line 16 of claim 1, "the" should be deleted from "the methionine biosynthesis." Same issue in claim 10, line 2.

Art Unit: 1616

(4) Merely reciting another fungicide as "a fungicidal compound (c)" is confusing and indefinite since one skilled in the art cannot possibly know, without more, what would qualify a compound as a "(c)" compound. See claim 11.

(5) Improper Markush language is used in claim 12. Correct language is "selected from the group consisting of ... and [last member]."

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of WO 2004/016088<sup>1</sup> and Hubele (US 5,153,200) in view of HCAPLUS abstract 1995:694232 and Hopkinson (US 6,746,988).

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<sup>1</sup> Prior art under 35 USC 102(e), international filing date of August 8, 2003.

WO 2004/016088 discloses applicant's compounds of formula (I) as fungicides. See pages 1-3. 0.05 to 99 wt% concentration strength is disclosed (page 6, lines 27-28). The specific compound of applicant's compound in instant claim 9 is expressly disclosed (page 3, line 14). Combination with one or more of other active compounds such as fungicides (preferred) or insecticides is disclosed for broadening spectrum of activity (page 7, lines 10-13). Combination with agriculturally acceptable support, carrier, filler or surfactant is disclosed (page 5, last paragraph to page 6, third paragraph). Seed treatment is disclosed (page 6, line 29 to page 7, line 8). Curative or preventive control of phytopathogenic fungi of crops is disclosed by applying an effective and non-phytotoxic amount to the seed, plant or fruit of the plant or to the soil in which the plant is growing or in which it is desired to grow (page 7, lines 15-30). Specific activity against various phytopathogenic fungi in various specific plants and specific application amounts, 10-800 g/hectare and 2-200 g/100 kg seed, are further disclosed (pages 8-11).

Hubele discloses cyprodinil as a well-tolerated fungicide to curatively or preventively protect crops of useful plants (paragraph bridging columns 1-2; column 3, last two lines; column 12, lines 26-39; column 16, Example 1.1). See columns 12-15 for specific disclosures on activity, application, formulation and crops to be protected: 50g to 5 kg/hectare application rate; 0.1-95 wt% concentration range; formulations with various carriers and surfactants; seed treatment. Activity against various fungal pathogens is disclosed (columns 90-92). Insecticidal activity as well as fungicidal

Art Unit: 1616

activity is disclosed (column 12, lines 26-30, 53-55). Combinations with other active agents such as other fungicides are disclosed (column 13, first full paragraph).

HCAPLUS abstract 1995:694232 discloses CGA 219417, an earlier name for cyprodinil, as a broad-spectrum fungicide for protection of various crops against many different fungi. Inhibition of methionine mode of action is disclosed, as well as its safety. Flexible use in integrated disease control practices is disclosed.

The patent by Hopkinson et al. is cited to establish that applicant's compound (b) and (c) fungicides are well-known fungicides, which are known to be used in combination. See claim 16, which discloses for example cyprodinil, mepanipyrim, trifloxystrobin, propineb, tolyfluanid, iprodione and many other well-known fungicides, and mixtures thereof.

The difference between the claimed invention and the cited references is that the references do not expressly disclose the specific combination of compound I + cyprodinil. However, both compounds have been taught by the prior art as agriculturally useful fungicides, and combination with other fungicides has been specifically suggested. Therefore, one having ordinary skill in the art would have been motivated to combine the fungicidal compound of formula I such as compound I with a well-known fungicide such as cyprodinil with the expectation of obtaining an advantageous fungicidal mixture, as claimed. In re Kerkhoven, 205 USPQ 1069, 1072 (CCPA 1980); In re Crockett, 126 USPQ 186 (CCPA); Ex parte The NutraSweet Co., 19 USPQ2d 1586, 1587 (Bd. Pat. App. & Int. 1991). Further addition of a third known fungicide such

Art Unit: 1616

as propineb would have been similarly suggested from the motivation to obtain additional activity and spectrum of control.

Regarding the claimed ratio of 0.01 to 20 (a to b), such ratio would have been obvious from the prior art concentration and application amounts, which when combined at their known amounts and rates would provide such ratio of components.

Applicant's specification data has been reviewed, but the data there is not commensurate in scope with that of the claims. Evidence of nonobviousness, if any, must be commensurate in scope with that of the claimed subject matter. In re Kulling, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990); In re Lindner, 173 USPQ 356, 358 (CCPA 1972). The table of data on specification page 11 is the only provided data for compound I + cyprodinil. While the data for 500 g/ha compound I + 31.2 g cyprodinil is greater than additive, it must be noted that this one data point is nowhere close to being commensurate in scope with that of the claimed subject matter. The claims require 0.01 to 20 ratio, whereas the tested ratio is only 16:1; and formula I compounds can vary significantly in their structures, which would affect how they would interact with cyprodinil since compounds of different structures would be expected to have different properties, whereas the tested formula I compound is only compound I. Consequently, there is insufficient evidence that results obtained with 500 g/ha compound I + 31.2 g cyprodinil would be predictive of similarly results for structurally different formula I compounds at different weight ratios of the compounds.

For these reasons, applicant's data is found insufficient and not commensurate in scope with that of the claimed subject matter. Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention and the claimed invention as a whole have been fairly disclosed or suggested by the teachings of the cited references.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Johann Richter, can be reached on **(571)272-0646**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Pak/  
Primary Examiner, Art Unit 1616